

Serial No.: 10/647,645
Response to Office Action

Docket No. 1009.13
Customer No. 53953

REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 1-28 are pending.

Rejection of the claims

The most recent Office Action rejected claims 1 and 16 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,940,812 ("Tengel").

Claim 1 recites:

1. A system, comprising:
a computing device for:
receiving first information about a customer;
to at least first and second loan sources, outputting second information
enabling the first and second loan sources to determine whether to
offer a loan to the customer for financing an item, wherein the second
information includes at least a portion of the first information;
from the first and second loan sources, receiving submissions of respective
first and second offers for providing the loan to the customer for
financing the item, wherein the first and second offers are submitted
by the first and second loan sources in response to the second
information and in a manner that commits to provide the loan if
accepted by the customer;
identifying at least one of the first and second offers as being most favorable;
and
to the customer, outputting third information about the identified offer,
wherein the third information includes an identity of at least one of the
loan sources that submitted the identified offer.

Serial No.: 10/647,645
Response to Office Action

Docket No. 1009.13
Customer No. 53953

Claim 16 recites:

16. A system, comprising:
a computing device for:
receiving first information about a customer, wherein the first information includes an identity of the customer;
in response to the first information, determining second information regarding the customer's ability to repay a loan;
to at least one loan source, outputting third information enabling the loan source to determine whether to offer the loan to the customer for financing an item, wherein the third information includes at least a portion of the first information and the second information, yet withholding the customer's identity;
from the loan source, receiving a submission of an offer for providing the loan to the customer for financing the item, wherein the offer is submitted by the loan source in response to the third information and in a manner that commits to provide the loan if accepted by the customer; and
to the customer, outputting fourth information about the offer, wherein the fourth information includes an identity of the loan source.

In MPEP § 2131, the PTO provides that:

"[t]o anticipate a claim, the reference must teach every element of the claim...."

Therefore, to sustain the rejection of claim 1, Tengel must contain all elements of claim 1. However, Tengel fails to contain all elements of claim 1. For example, Tengel fails to teach the following elements of claim 1:

to at least first and second loan sources, outputting second information enabling the first and second loan sources to determine whether to offer a loan to the customer for financing an item, wherein the second information includes at least a portion of the first information;

from the first and second loan sources, receiving submissions of respective first and second offers for providing the loan to the customer for financing the item, wherein the first and second offers are submitted by the first and second loan sources in response to the second information and in a manner that commits to provide the loan if accepted by the customer.

Instead, Tengel teaches away from such elements, because Tengel states (at col. 9 line 60 through col. 10 line 16):

Serial No.: 10/647,645
Response to Office Action

Docket No. 1009.13
Customer No. 53953

"From the rankings of best loans, the potential borrower chooses a selected loan provided by a selected lender (step 218). The selected loan depends on which loan attributes are most important to the potential borrower. In the case of one lender providing all of the offered loans, the selected lender is always that one lender.

"Referring to FIG. 7, a selected lender display 700 is shown on a consumer screen 750 of a consumer terminal. This display shows information regarding the selected loan and the selected lender. This information includes the lender's name, phone number, address, and contact name, and the loan attributes of the selected loan. The selected lender display 700 asks the potential borrower at the bottom of the display 702 if a loan application should be submitted to this lender for the purpose of consummating the loan transaction. If the potential borrower responds with a "Y" for "yes", the loan origination system of the present invention automatically generates a loan application from the borrower attributes of the potential borrower (step 220). This loan application is then sent via the global telecommunications network to that lender for loan approval (step 222).

"When this lender receives this loan application, the lender will complete the loan underwriting process to decide whether to provide a loan to the potential borrower."

Thus, Tengal teaches that the potential borrower's information is sent to the *selected* lender *after* the selected lender is selected by the potential borrower, which occurs *after* the lender specifies "loan attributes" and "loan acceptance criteria" for its "offered loan." Claim 1 recites the element of outputting second information (including at least a portion of the first information about the customer) enabling *first* and *second* loan sources to determine whether to offer a loan to the customer for financing an item, which occurs *before* receiving the submissions of the respective first and second offers from the first and second loan sources and *before* identifying at least one of the first and second offers as being most favorable.

In contrast with claim 1, Tengal teaches that its offered loan is *not* submitted by its lender in response to the "second information" of claim 1, but instead is submitted by its lender at an earlier time (e.g., *before* the potential borrower's information is received), and in a manner that does *not* commit to provide the loan if accepted by the potential borrower (e.g., *see* above-quoted statement from Tengal, col. 10 lines 14-16, "When this lender receives this loan application, the lender will complete the loan underwriting process to decide whether to provide a loan to the potential borrower"). Thus, Tengal teaches that the selected lender will "decide whether to provide a loan to the potential borrower," but only *after* the potential borrower submits a loan application to the selected lender, which occurs only *after* the

Serial No.: 10/647,645
Response to Office Action

Docket No. 1009.13
Customer No. 53953

potential borrower chooses the selected lender, which occurs only *after* the lender specifies "loan attributes" and "loan acceptance criteria" for its "offered loan." Consequently, Tengel's "offered loan" is submitted by its lender in a manner that does *not* commit to provide the loan if accepted by the potential borrower, which is contrary to the elements of claim 1.

Therefore, Tengel fails to support a rejection of claim 1 under 35 U.S.C. § 102(e).

Also, Tengel fails to support a rejection of claim 16 under 35 U.S.C. § 102(c). For example, Tengel fails to teach "withholding the customer's identity" in the manner recited by claim 16. Moreover, Tengel fails to teach the following elements of claim 16:

- to at least one loan source, outputting third information enabling the loan source to determine whether to offer the loan to the customer for financing an item, wherein the third information includes at least a portion of the first information and the second information, yet withholding the customer's identity;
- from the loan source, receiving a submission of an offer for providing the loan to the customer for financing the item, wherein the offer is submitted by the loan source in response to the third information and in a manner that commits to provide the loan if accepted by the customer.

As discussed hereinabove, Tengel teaches that the potential borrower's information is sent to the *selected* lender *after* the selected lender is selected by the potential borrower, which occurs *after* the lender specifies "loan attributes" and "loan acceptance criteria" for its "offered loan." Claim 16 recites the element of outputting third information (including at least a portion of the first information about the customer and the second information regarding the customer's ability to repay a loan) enabling the loan source to determine whether to offer the loan to the customer for financing an item, which occurs *before* receiving the submission of the offer from the loan source.

In contrast with claim 16, Tengel teaches that its offered loan is *not* submitted by its lender in response to the "third information" of claim 16, but instead is submitted by its lender at an earlier time (e.g., *before* the potential borrower's information is received), and in a manner that does *not* commit to provide the loan if accepted by the potential borrower (e.g., see above-quoted statement from Tengel, col. 10 lines 14-16, "When this lender receives this loan application, the lender will complete the loan underwriting process to decide whether to

Serial No.: 10/647,645
Response to Office Action

Docket No. 1009.13
Customer No. 53953

provide a loan to the potential borrower”). Thus, Tengel teaches that the selected lender will “decide whether to provide a loan to the potential borrower,” but only *after* the potential borrower submits a loan application to the selected lender, which occurs only *after* the potential borrower chooses the selected lender, which occurs only *after* the lender specifies “loan attributes” and “loan acceptance criteria” for its “offered loan.” Consequently, Tengel’s “offered loan” is submitted by its lender in a manner that does *not* commit to provide the loan if accepted by the potential borrower, which is contrary to the elements of claim 16.

Therefore, Tengel fails to support a rejection of claim 16 under 35 U.S.C. § 102(e).

Moreover, Tengel fails to establish a *prima facie* case of obviousness. As stated in MPEP § 2142, “...The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness...”

In this case, the cited aspects of Tengel fail to teach, or even suggest, the desirability of the claimed combinations. Accordingly, they clearly fail to provide any incentive or motivation supporting the desirability of the claimed combinations. Such incentive and motivation would arise solely from hindsight based on Applicant’s teachings. Consequently, Tengel fails to provide any basis for combining in a 35 U.S.C. § 103 rejection.

Thus, in view of the reasons stated herein, and for other reasons clearly apparent, the PTO has not met its burden of factually supporting a *prima facie* conclusion of obviousness in this case, and Applicant has no obligation to submit evidence of nonobviousness.

Therefore, a rejection of claims 1 and 16 is not supported.

Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1 and 16

Dependent claims 2-15 depend from and further limit claim 1 and therefore are allowable.

Serial No.: 10/647,645
Response to Office Action

Docket No. 1009.13
Customer No. 53953

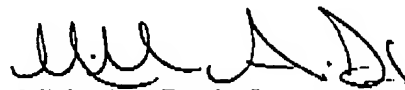
Dependent claims 17-28 depend from and further limit claim 16 and therefore are allowable.

To the extent that this Response to Office Action results in additional fees, the Commissioner is authorized to charge deposit account no. 50-3524.

An early formal notice of allowance of claims 1-28 is requested.

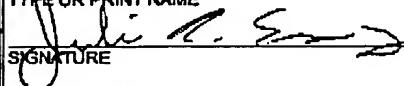
Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,



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